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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,792	07/16/2004	Michael John Sleeman	069918.007	6909
<div>James E Bradley Bracewell &amp; Patterson PO Box 61389 Houston, TX 77208-1389</div>				
<div>7590 07/25/2007</div>			<div>EXAMINER CHEVALIER, ALICIA ANN</div>	
			<div>ART UNIT 1772</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 07/25/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/501,792

**Applicant(s)**

SLEEMAN ET AL.

**Examiner**

Alicia Chevalier

**Art Unit**

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-25 and 28-36 is/are pending in the application.
- 4a) Of the above claim(s) 32-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-25 and 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **RESPONSE TO AMENDMENT**

1. Claims 19-25 and 28-36 are pending in the application, claims 32-36 and withdrawn from consideration.
2. Amendments to the specification and the claims, filed on May 2, 2007, have been entered in the above-identified application.

### ***WITHDRAWN REJECTIONS***

3. The objections to the specification, made of record in the office action mailed December 29, 2006, page 2, paragraph #5 have been withdrawn due to Applicant's amendment in the response filed May 2, 2007.
4. The 35 U.S.C. §112 rejections, made of record in the office action mailed December 29, 2006, page 3, paragraph #7 have been withdrawn due to Applicant's amendment in the response filed May 2, 2007.
5. The 35 U.S.C. §102 rejections, made of record in the office action mailed December 29, 2006, pages 3-7, paragraphs #9 and #10 have been withdrawn due to Applicant's amendment in the response filed May 2, 2007.

### ***REJECTIONS***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

7. Claims 19-25 and 28-30 and are rejected under 35 U.S.C. 102(b) as being anticipated by Faykish et al. (U.S. Patent No. 5,080,463).

Regarding Applicant's claim 19, Faykish discloses a retroreflective material (*title*) comprising an underlying substrate on which a coating and a plurality of beads are located (*figure 6, reference #16, #20, #19 and #22*). The coating is located between the underlying substrate and the beads (*figure 6*). The coating applied to at least a portion of the plurality of beads to produce or enhance retroreflectivity of the plurality of the beads (*col. 6, lines 13-57*). The coating bridges at least some gaps between the plurality of beads (*figure 6*). The coating comprises areas of contrast comprising at least one of areas in which the coating does not bridge the gaps between the beads or areas in which the coating bridging the gaps is treated (*col. 5, lines 43-61*).

Regarding Applicant's claim 20, Faykish discloses the areas in which the coating bridges the gaps between the beads and the areas in which the coating does not bridge the gaps between the beads are selected so that the areas of contrast represent patterning and/or graphical and/or pictorial matter (*col. 5, lines 43-61*).

Regarding Applicant's claim 21, Faykish discloses that the coating bridging substantially all gaps between the beads is removed or treated (*figure 6 and col. 5, lines 43-61*).

Regarding Applicant's claims 22 and 23, Faykish's retroreflective sheeting is deemed to be in the form of a tap or sheet since it meets all the limitations of the claim and is adhesive (*figure 6 and col. 3, lines 50-61*).

Regarding Applicant's claim 24, Faykish discloses that the coating is discontinuous in a way to expose the underlying substrate (*figure 6*).

Regarding Applicant's claim 25, Faykish discloses that the underlying substrate is colors (*col. 7, lines 13-16*).

Regarding Applicant's claims 28 and 29, Faykish discloses that the coating is metal based (*col. 6, lines 13-14*). The limitation "in which the coating has been affected by metallization" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Balley discloses a metal coating.

Regarding Applicant's claims 30, Faykish discloses that the coating comprises a medium containing elements importing retreflectivity (*col. 6, lines 13-14*).

8. Claims 19-25 and 28-31 and are rejected under 35 U.S.C. 102(b) as being anticipated by Palmquist et al. (U.S. Patent No. 2,543,800).

Regarding Applicant's claim 19, Palmquist discloses a retroreflective material (*title*) comprising an underlying substrate on which a coating and a plurality of beads are located (*figure 3*). The coating is located between the underlying substrate and the beads (*figure 3*). The coating applied to at least a portion of the plurality of beads to produce or enhance retrorefletivity of the plurality of the beads (*col. 3, lines 50-57*). The coating bridges at least

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some gaps between the plurality of beads (*figure 3*). The coating comprises areas of contrast comprising at least one of areas in which the coating does not bridge the gaps between the beads or areas in which the coating bridging the gaps is treated (*figure 3*).

Regarding Applicant's claim 20, Palmquist discloses the areas in which the coating bridges the gaps between the beads and the areas in which the coating does not bridge the gaps between the beads are selected so that the areas of contrast represent patterning and/or graphical and/or pictorial matter (*figure 3*).

Regarding Applicant's claim 21, Palmquist discloses that the coating bridging substantially all gaps between the beads is removed or treated (*figure 3*).

Regarding Applicant's claims 22 and 23, Palmquist's retroflective sheeting is deemed to be in the form of a tap or sheet since it meets all the limitations of the claim (*figure 3*).

Regarding Applicant's claim 24, Palmquist discloses that the coating is discontinuous in a way to expose the underlying substrate (*figure 3*).

Regarding Applicant's claim 25, Palmquist discloses that the underlying substrate is colors (*figure 3*).

Regarding Applicant's claims 28 and 29, Palmquist discloses that the coating is metal based (*figure 3*). The limitation "in which the coating has been affected by metallization" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art

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structure and the structure resulting from the claimed method because Balley discloses a metal coating.

Regarding Applicant's claims 30 and 31, Palmquist discloses that the coating comprises a medium containing elements importing retroreflectivity, such as metal flakes (*figure 3*).

### ***ANSWERS TO APPLICANT'S ARGUMENTS***

9. Applicant's arguments in response filed May 2, 2007 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

7/22/07



**ALICIA CHEVALIER  
PRIMARY EXAMINER**